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No. 95-26

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

HERBERT MARKMAN AND POSITEK, INC.,
Petitioners,

v.

WESTVIEW INSTRUMENTS, INC. AND
ALTHON ENTERPRISES, INC.,
Respondents.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

REPLY BRIEF FOR PETITIONERS

Of Counsel

LEWIS F. GOULD, JR.
STEPHAN P. GRIBOK
ECKERT SEAMANS CHERIN
& MELLOTT
1700 Market Square
Suite 3232
Philadelphia, PA 19103
(215) 575-6000

WILLIAM B. MALLIN
Counsel of Record
TIMOTHY P. RYAN
TIMOTHY S. COON
ECKERT SEAMANS CHERIN
& MELLOTT
600 Grant Street
42nd Floor
Pittsburgh, PA 15219
(412) 566-6000

Attorneys for Petitioners
Herbert Markman and
Positek, Inc.

28 pp

(i)

TABLE OF CONTENTS

TABLE OF AUTHORITIES (ii)

1.	Respondents Misstate Both The Record And The Basis For The Opinions Of The Courts Below	1
2.	Respondents Mischaracterize Petitioners' Argument Where There Is A Genuine Issue Of Material Fact	5
3.	Respondents Misstate The Scope Of The Seventh Amendment Right To Jury Trial	6
4.	The Historical Record Establishes That Interpretive Disputes As To The Meaning Of Patents Must Be Resolved By The Factfinder	7
5.	Respondents' Discussions Of The Precedents Of This Court Are Irrelevant And Mistaken	14
6.	The Need For Construing Claim Terms Does Not Render The Patent Void For Vagueness	17
7.	The Analogous Interpretive Issues Urged By Respondents Are Erroneous . .	18

(ii)

TABLE OF AUTHORITIES

Cases

<i>Bischoff v. Weathered</i> , 76 U.S. (9 Wall) 812 (1869)	15, 16
<i>Boulton v. Bull</i> , DAVIES PATENT CASES 162 (Common Pleas 1795)	8
<i>Bovill v. Moore</i> , DAVIES PATENT CASES 361 (Common Pleas 1816)	10, 12
<i>Brooks v. Fiske</i> , 56 U.S. (15 How.) 212 (1853)	12
<i>Century Electric Co. v. Westinghouse Electric & Mfg. Co.</i> , 191 F. 350 (8th Cir. 1911)	19
<i>Coupe v. Royer</i> , 155 U.S. 565 (1895)	15, 16
<i>DMI, Inc. v. Deere & Co.</i> , 755 F.2d 1570 (Fed. Cir. 1985)	4
<i>Dimick v. Schiedt</i> , 293 U.S. 474 (1935)	7
<i>E. I. DuPont de Nemours & Co. v. Phillips Petroleum Co.</i> , 849 F.2d 1430 (Fed. Cir.), <i>cert. denied</i> , 488 U.S. 986 (1988)	13
<i>Evans v. Eaton</i> , 20 (7 Wheat) U.S. 161, (1822)	12, 14

(iii)

<i>Finney v. Guy</i> , 189 U.S. 335 (1903)	20
<i>Goodyear Dental Vulcanite Co. v. Davis</i> , 102 U.S. 222 (1880)	19
<i>Granfinanciera S.A. v. Nordberg</i> , 492 U.S. 33 (1989)	13
<i>Harries v. Air King Products Co.</i> , 183 F.2d 158 (2d Cir. 1950)	14
<i>Heald v. Rice</i> , 104 U.S. 737 (1881)	16, 17
<i>Hilton Davis Chemical Co. v. Warner- Jenkinson Co.</i> , 62 F.3d 1512 (Fed. Cir. 1995)	13
<i>Huddart v. Grinshaw</i> , DAVIES PATENT CASES 265 (K. B. 1803)	10
<i>Hogg v. Emerson</i> , 47 U.S. (6 How.) 437 (1848)	17
<i>Intervet America, Inc. v. Kee-Vet Lab, Inc.</i> , 887 F.2d 1050 (Fed. Cir. 1989)	9, 10
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. 274 (1877)	17
<i>Kneass v. Schulykill Bank</i> , 14 F. Cas. 746 (Cir. Pa. 1820)	14
<i>Liardet v. Johnson</i> (K.B. 1778)	8, 9
<i>Loom Co. v. Higgins</i> , 105 U.S. 580 (1881)	17

(iv)

<i>Market Street Cable Ry. Co. v. Rowley</i> , 155 U.S. 621 (1895)	17
<i>Macbeath v. Haldimand</i> , 1 T.R. 172, 99 Eng. Rep. 1036 (K.B. 1786)	10
<i>Morris v. Bramsom</i> , DAVIES PATENT CASES 202 (K.B. 1776)	10, 12
<i>Neilson v. Harford</i> , WEBSTER PATENT CASES 295 (Exch. 1841)	8
<i>North American Vaccine, Inc. v.</i> <i>American Cyanamid Co.</i> , 7 F.3d 1571 (Fed. Cir. 1993)	18
<i>Philadelphia and Trenton Railroad Co.</i> <i>v. Stimpson</i> , 39 U.S. (14 Pet.) 376 (1840)	12
<i>R v Else</i> (1785), DAVIES PATENT CASES 144, 1 WEBSTERS PATENT CASES 76	12
<i>Silby v. Foote</i> , 55 U.S. (14 How.) 218 (1853)	12
<i>Singer Mfg. Co. v. Cramer</i> , 192 U.S. 265 (1904)	17
<i>Teamsters v. Terry</i> , 494 U.S. 558 (1990)	7
<i>Tucker v. Spaulding</i> , 80 U.S. (13 Wall.) 453 (1871)	16
<i>Turner v. Winter</i> , 1 T.R. 602 (K.B. 1778)	8

(v)

<i>United States v. State Investment Co.</i> , 264 U.S. 206 (1924)	20
<i>Walker v. New Mexico & S. Pac.</i> <i>R.R. Co.</i> , 165 U.S. 593 (1879)	7
<i>Washburn v. Gould</i> , 29 F. Cas. 312 (C.C.D. Mass. 1844)	13
<i>Winans v. Denmead</i> , 56 U.S. (15 How.) 339 (1853)	15
<i>Winans v. New York & Erie R.R. Co.</i> , 62 U.S. (21 How.) 88 (1859)	14, 15

Constitution

U.S. Const. amend. VII	passim
------------------------------	--------

Statutes

35 U.S.C. § 112	9, 17
Act of 1870, Ch. 230, § 26, 16 Stat. 198 (July 8, 1870)	11
Act of 1836, Ch. 375, § 6, 5 Stat. 117 (July 4, 1836)	11
Act of April 10, 1790, Ch. 7, § 1, 1 Stat. 109	11

Other Sources

ADAMS & AVERLY, THE PATENT SPECIFICATION: THE ROLE OF LIARDET V. JOHNSON, 7 J. Legal Hist. 156 (1986)	12
A. CORBIN, CORBIN ON CONTRACTS, §§ 534, 554 . .	19, 20
ESSAY, NOTE ON THE PATENT LAWS, 3 Wheaton 655 (1818)	7
E. WALTERSCHEID, THE EARLY EVOLUTION OF THE UNITED STATES PATENT LAW: ANTECEDENTS (Part 3), 77 J. Pat. & T. Off. Soc'y 771 (1995)	9
GERALD GUNTHER, LEARNED HAND: THE MAN AND THE JUDGE, 138 (1994)	14
I J. OLDHAM, "THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY (Chapel Hill & London, 1992)	6, 8
S. WILLISTON, WILLISTON ON CONTRACTS, §§ 602, 616 (3d Ed. 1961)	19, 20

REPLY BRIEF FOR PETITIONERS

Petitioners submit this Reply Brief to reply to the contentions of respondents and certain *amici*. Respondents and their supporting *amici* respond to contentions not advanced by petitioners, misstate the record below, mischaracterize the opinions of the trial judge and the Federal Circuit and misconstrue the precedent of this Court. In apparent recognition that their position on the Constitutional issue before the Court is wrong, respondents and these *amici* attempt to convince this Court not to address the Constitutional question raised by this case and, failing that, advance a position that would undermine the Seventh Amendment right to a jury trial on infringement issues in patent litigation.

1. Respondents Misstate Both The Record And The Basis For The Opinions Of The Courts Below.

Respondents mistakenly suggest that the decisions of the trial judge and the majority were predicated upon holdings that there was no genuine dispute as to the meaning of the patent terms at issue and that the "correct" construction of the patent arrived at below could be ascertained from the patent documents as a matter of law. This simply is untrue. The trial judge here based his decision on his misdirected view that the interpretation of a patent is always a question of law reserved exclusively for the judge's decision. In his view, the jury's verdict of infringement could be discarded by labelling the issue a legal question.

Respondents state that "[t]he trial court determined the meaning of the patent claims as a matter of law from the patent documents." Opp. 2. This statement, which forms the foundation for respondents' arguments to this Court, is false. The trial judge did not cite a single passage from the claims, the patent specification or the file history to support his erroneous interpretation of the term inventory which is not defined in these documents. Instead, the trial judge, relied on extrinsic evidence, weighed evidence, evaluated credibility, rejected evidence and disregarded express admissions of

respondents to support his erroneous factual findings, because he insisted that interpretation of a patent is always a legal question.

Claim 1 of the '054 patent requires that the system "maintain an inventory total." At trial, petitioners introduced evidence to establish what the term "inventory" meant to one of ordinary skill in the relevant art—a meaning consistent with the specification and file history. The trial judge rejected this evidence and adopted, without an appropriate evidentiary foundation, constructions of the term "inventory" which he stated were the "ordinary and customary meanings" of the term.¹ He concluded that "[i]nventory means articles of clothing" and that to infringe the patent, the accused system must maintain an inventory of descriptions of articles of clothing. There was no evidence that the '054 patent requires the system to keep in its memory indefinitely the descriptions of articles of clothing. The trial judge did not cite to the evidence upon which he relied in making factual determinations as to the "ordinary and customary meaning" of the term at issue.

According to respondents: "Markman's system, as defined by the patent, tracks articles of clothing through the dry cleaning process. The tracking of articles is accomplished by printing bar-coded article tags, attaching the tags to articles of clothing and scanning them at predetermined stations." Opp. 5. Respondents' description is incorrect. The infringed claims of the '054 patent do not require that bar coded tags be attached to individual articles or that such articles be monitored as they move through the drycleaning process. As the

¹See, e.g., *Trial Judge's Opinion* at 137a, "[t]hese definitions [of petitioners' expert] are contrary to the ordinary and customary meanings of these terms . . ."; "Plaintiffs' technical expert's testimony is based on an artificial interpretation of key words and phrases that runs counter to their ordinary meaning."

evidence at trial established, the patent's requirement of a "memory operable to record said information" is satisfied if the accused system possesses memory which enables it to record or print information regarding the articles.² The trial judge's erroneous conclusion is not supported by the claims, the patent specification, its prosecution history or other evidence. The jury's finding is supported by the evidence.

Respondents also mischaracterize the claims of the '054 patent as requiring the patented system to track individual articles of clothing through the drycleaning process. Though this may well describe a preferred embodiment of the '054 patent, it misrepresents the elements of independent claim 1, a claim of the '054 patent which respondents infringed as found by the jury. Having the capability to generate individual garment tags and thereby track individual garments through the drycleaning process is but one possible embodiment of the invention, an embodiment not required in claim 1. To the contrary, throughout the patent specification, the invention is described in terms of controlling "batches" or groups of articles in inventory. The trial judge's conclusion that the '054 patent requires individual articles of clothing and not batches to be processed is defective.

By reading into independent claim 1 the requirement of attachment of individual bar coded tags to individual articles of clothing (and thereby enabling the system to track individual articles), the trial judge erroneously read into claim 1 additional claim elements contained in dependent claims 5 and 6. However, dependent claims 5 and 6 are not limitations of claim 1. The Federal Circuit has held repeatedly that it is improper to read the requirements of a dependent claim into

²See, e.g., Testimony of inventor that "The primary claim, Claim 1, does not require that the system retain details as far as the articles associated with the ticket after the ticket is produced." App. 188.

an independent claim. *See, e.g., DMI, Inc. v. Deere & Co.*, 755 F.2d 1570, 1574 (Fed. Cir. 1985). Consequently, claim 1 of the '054 patent does not require that individual garments be tracked through the drycleaning process. As found by the jury based on the evidence, the accused system infringes claim 1 as it requires only that the "written record" be attached to articles, either individually or in batches.

The evidence introduced at trial does not lend support to the judge's conclusion or, at the very least, there is substantial evidence supporting the jury's contrary interpretation. The evidence established that the ordinary meaning of inventory as used in the drycleaning industry is not limited to articles of clothing. Rather, Westview conceded that: "inventory" may mean dollars or it may mean articles of clothing; that both kinds of inventory are important in the industry; that the accused system was designed to account for inventory in both dollar and invoice forms; and that the accused system maintains an inventory by listing the invoices representing the batches of articles taken in by an establishment.

Respondents, recognizing that their position on the law is without support, now attempt to redraft the majority opinion to hold something which it does not. According to respondents: "The Court agreed that the trial court properly used the patent documents to interpret the claims and, upon review of the claim language, specification and prosecution history, concluded that the district court's claim construction was correct." *See*, Opp. 14. This simply is not the case. The trial judge did not predicate his findings on the claim language, the specification or the prosecution history, nor did he apply the substantial evidence standard. Rather, the trial judge, guided by the fiction that construing the claim terms is always a legal question, rejected the jury's findings by ignoring evidence, reweighing evidence and drawing unsupported inferences from the evidence.

The majority similarly adopted the position that it, upon *de novo* review, should weigh evidence and make credibility determinations *en route* to resolving claim construction issues as a legal question. The majority opinion did not conclude that the jury's verdict was not supported by substantial evidence. Like the trial judge, the majority concluded that judges must always interpret patents as a matter of law in every infringement action for damages. As respondents concede, but characterize as the "general holding," the Federal Circuit squarely held that "in a case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim." 30a.

This legal question now stands at the very threshold of every patent infringement suit. Indeed, the majority explicitly rejected the notion that the issue was not before it; it emphasized that "Markman squarely raised the issue of whether the court acted within its power in granting JMOL after the jury had construed the claims," 55a, and denied that its decision concerning the proper allocation of functions between judge and jury as to claim construction issues was dictum. The majority's constitutional holding which governs every infringement case in the nation is before this Court for decision.

2. Respondents Mischaracterize Petitioners' Argument Where There Is A Genuine Issue Of Material Fact.

Respondents contend that petitioners here are advancing the argument that the interpretation of claim language is triable to a jury irrespective of the existence of a genuine issue of material fact. Opp. 19. This misstates petitioners' position. *See* petitioners' Question Presented for Review: "In a patent infringement action for damages, is there a right to a jury trial under the Seventh Amendment to the United States Constitution of genuine factual disputes about the meaning of a patent?" Petitioners concede that if no triable issue of fact exists, the trial judge may withdraw the issue from the jury.

Pet. Brief at 35. But where there is a dispute of fact, the issue cannot be taken from the jury by simply saying that the issue is always a legal question.

3. Respondents Misstate The Scope Of The Seventh Amendment Right To Jury Trial.

Respondents argue that the right to jury trial on issues of patent interpretation does not attach because such issues are mere "incidents" or "procedural details." This argument is unsupportable in both law and logic.³ As Judge Mayer's concurring opinion below recognized, "[t]o decide what the claims mean is nearly always to decide the case" and "[n]ot infrequently, the ultimate question of infringement, indisputably a matter for the jury, is effectively dictated by the construction given the patent claims." 57a; 67a.

This Court's teachings are clear that the Seventh Amendment bestows upon a litigant in a civil case the right to trial by jury as to those issues which go to the "fundamental elements"

³Respondents' contention that "[h]ere the trial judge's use of the directed verdict device in determining the meaning of the claims as a matter of law was directly in line with the power of judges under the common law" begs the question before the Court which is a litigant's fundamental right to trial by jury as to issues of claim construction when there exist genuine disputes of fact as to the meaning of terms used in the patent. Additionally, respondents' contention in and of itself is inaccurate. Respondents fail to acknowledge, as a leading commentator has explained, that the concept of a "directed verdict" in eighteenth century trial practice "differs from the modern concept of the directed verdict as a final determination. The eighteenth-century jury was considered to have a moral obligation to follow the direction of the judge in his construction of applicable laws, but there was no legal obligation to do so. Nevertheless, trial judges did frequently direct juries to find for one party or the other, and juries ordinarily complied." I J. OLDHAM, *THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY* (1992) at p. 150. This practice, which did not limit the power of the jury at common law, is no basis for restricting the role of the jury today.

or the "substance of the common law right of trial by jury." *Walker v. New Mexico & S. Pac. R.R. Co.*, 165 U.S. 593, 596 (1897). Issues of claim construction constitute "fundamental elements" and, as Judge Mayer recognized, in most cases go to the very heart of the common law right of trial by jury of infringement issues in a patent suit. Petitioners' right to trial by jury cannot be extinguished by relabelling this central issue as a "procedural incident."

4. The Historical Record Establishes That Interpretive Disputes As To The Meaning Of Patents Must Be Resolved By The Factfinder.

Respondents do not dispute that the Seventh Amendment guarantees a jury trial in all cases where legal as opposed to equitable rights are at issue. *Teamsters v. Terry*, 494 U.S. 558, 564-65 (1990). That distinction incorporates English practice as of 1791. *Dimick v. Schiedt*, 293 U.S. 474, 476 (1935). Curiously, the majority conducted no historical analysis to determine whether interpretation of the patent was an issue triable to a jury at common law. Respondents likewise proclaim that "[h]istorical analysis . . . provides limited guidance in examining the particular question of whether the judge or the jury interprets patent claims." Opp. at 23.⁴

⁴*Amicus* U.S. Surgical's efforts to undermine the significance of the state of English patent law as of 1791 are misleading. Its contention that "[p]atent law in England as [sic] that time was scarcely describable" is inaccurate. As of the time of the adoption of the Seventh Amendment, a well defined body of English case law had developed and was being applied. See Essay, Note on the Patent Laws, 3 Wheaton 655 (1818) describing legal principles discernable from the "great variety" of English decisions. U.S. Surgical's statement that "[t]here was no coherent body of English patent law to be known by the enactors of the Seventh Amendment" is mistaken. It is important to emphasize that the Seventh Amendment incorporates the *common law*, not English textbooks.

(continued...)

The rationale underlying respondents' efforts to deflect the Court's attention away from the proper analysis is simple — it is beyond question that according to the common law of England as of 1791 the jury has always had a role in determining a patent's scope. Respondents' attempts to distinguish the leading authorities on this point are unconvincing. Respondents contend that *Liardet v. Johnson* (K.B. 1778); *Turner v. Winter*, 1 T.R. 602 (K.B. 1787); and *Neilson v. Harford*, WEBSTER PAT. CAS. 295 (Exch. 1841), are distinguishable because these cases involved patent validity determinations based on the alleged insufficiency of the patent

⁴(...continued)

Whether or not there was a coherent, articulated body of patent law in the English law texts of the late 18th century, there was no uncertainty about what the functions of judge and jury were in the conduct of the many patent trials that had by then occurred. Concerning the volume of patent litigation, U.S. Surgical's statement that "there were only 18 patent decisions at common law in England" is incorrect and misleading. Until the very end of the 18th Century, there was no court reporting at the trial level. J. OLDHAM p. 164. For example, in Lord Mansfield's surviving trial notes (which cover only about one-half of Lord Mansfield's cases), there are 11 patent trials described, none of which was reported contemporaneously. See J. OLDHAM. Additionally, there were unreported patent trials being conducted during the 18th Century in England in the Court of Common Pleas and the Court of Exchequer, the vast majority of which went unreported. These facts explain Justice Buller's remark in 1787 that "[m]any cases upon patents have arisen within our memory," and the observation of Chief Justice Eyre of Common Pleas in 1795 that "we have heard many cases upon patents." *Turner v. Winter*, 1 T.R. 602, 602; *Boulton v. Bull*, Davies Pat. Cas. 162, 204, respectively. Moreover, even the reporting that did take place when the full courts sat was selective and intermittent. J. OLDHAM at 118-19, 1814. Consequently, U.S. Surgical's report concerning the volume of precedents existing in England in the 18th Century does not undercut to any extent the state of the English common law discussed in petitioners' Brief.

specification.⁵ However, respondents ignore the fact that determinations concerning validity, like infringement, require the patent to be interpreted and that juries making those interpretive determinations performed that specific function in England as of 1791.⁶ It has been consistently held as logic dictates that patents must be interpreted identically for purposes of both validity and infringement. See, e.g., *Intervet America, Inc. v. Kee-Vet Lab, Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989) ("[c]laims must be given the same construc-

⁵The description of the *Liardet* decision advanced by *amicus* U.S. Surgical is flatly wrong and demonstrates its lack of understanding of the English precedents applicable here. Contrary to U.S. Surgical's contention that *Liardet* was "not a decision reviewed by the King's Bench," the case was reviewed before the full Court of King's Bench which ordered a new trial. Moreover, petitioners' statement of Lord Mansfield's instructions to the jury to determine "all objections made to exactness, certainty and propriety of the specification" is precisely correct. This portion of the jury instruction is taken directly from Justice Buller's handwritten notes of the case, not as U.S. Surgical contends, from Justice Buller's work, *TRIALS AT NISI PRIUS*, or from a party's "pamphlet." U.S. Surgical apparently does not recognize that Justice Buller was a judge on the King's Bench who participated in hearing and deciding the motion for a new trial in the *Liardet* case. Even U.S. Surgical's most recent secondary authority states that, in the ascendance of the specification in English patent law, *Liardet v. Johnson* "led the way." E. Walterscheid, *THE EARLY EVOLUTION OF THE UNITED STATES PATENT LAW: ANTECEDENTS (PART 3)*, 77 J. Pat. & T. Off. Soc'y 771, 801 (1995). *Liardet* is a leading English patent case which unequivocally demonstrates that English juries as of 1791 were called upon to decide issues of patent interpretation.

⁶For example, in *Liardet*, in proving whether the challenged invention was "new", it was necessary for the jury to compare the specification to comparable inventions in dictionaries, other printed sources and as described in testimony. In doing so, the jury necessarily had to discern the "subject matter which the applicant regards as his invention." See, 35 U.S.C. § 112.

tion when considering infringement as when considering validity.") (emphasis in original).

Respondents also attempt to distinguish several other leading cases on the basis that the juries in those cases were called upon to decide whether the invention subject to the patent was "new" in light of the accused device or other prior art. In both *Huddart v. Grinshaw*, DAVIES PAT. CAS., 265 (K.B. 1803) and *Bovill v. Moore*, DAVIES PAT. CAS., 361 (C. P. 1816), the juries interpreted the terms of the patents at issue in order to determine whether a new invention was disclosed. In each of these cases, the jury was assigned the task of determining the scope of the words used in the patent disclosure so as to enable them to pass upon the invention's novelty. See also, *Morris v. Bramson*, 1 DAVIES PAT. CAS. 202, 203 (K.B. 1776) (an improvement on an existing machine could be patented; however, as Justice Buller stated, "it must be for the addition only and not for the old machine too" thereby requiring the jury to construe the patent specification to determine whether an alleged new improvement to the existing machine was disclosed).⁷

Respondents attempt to further undermine the significance of these English precedents by contending that such jury determinations concerning the scope of a patent have "no

⁷Respondents' citation of *Macheath v. Haldimand*, 1 T.R. 172, 99 Eng. Rep. 1036 (K.B. 1786), cannot support the proposition advanced by respondents as that case dealt only with the construction of written documents and letters about which there was no factual disagreement to be submitted to the jury. Tellingly, Justice Buller observed that if letters "be written in so dubious a manner, as to be capable of different constructions, and can be explained by other transactions, the whole evidence must be left to the jury to decide upon; for they are to judge of the truth or falsehood of such collateral facts which may vary the sense of the letters themselves: but if they be not explained by any other circumstances, then, like deeds or other written agreements, the construction of them is a mere matter of law." 1 T.R. at 182.

precise correlate in the historic record to modern patent infringement actions because the system of patent claiming has changed in style and content." Opp. 31-32. In essence, respondents and certain of their supporting *amici* contend that because the statutory requirement of a claim did not appear in this country until 1836, prior precedents construing patent specifications (rather than strictly "claims") are irrelevant. These contentions are without merit.

The patent laws in the United States, like those of England prior to 1791, have always required inventors to point out their inventions in detail sufficient to distinguish any relevant prior art and to disclose to the public what protection the patent confers. The first patent statute enacted in this country required that the patent "describ[e] the said invention or discovery, clearly, truly and fully." Act of April 10, 1790, Ch. 7, § 1, 1 Stat. 109. Not unlike the procedure in modern practice, as of 1791 in the United States the applicant for a patent was required to submit "a specification in writing, containing a description . . . of the thing or things by him or them invented or discovered, . . . which specification shall be so particular . . . as . . . to distinguish the invention or discovery from other things before known and used." *Id.* § 2. The Act of 1836, ch. 357, § 6, 5 Stat. 117 (July 4, 1836) expressly included the word "claim" requiring that the applicant "[s]hall particularly specify and point out the part, improvement or combination, which he claims as his own invention." Claims as commonly used today were expressly made part of patent law by the Act of 1870, Ch. 230 § 26, 16 Stat. 198 (July 8, 1870), which mandated that an applicant for a patent "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."

This evaluation is wholly irrelevant to the Seventh Amendment analysis. Claims, much as they are presently employed,

were in common use even before the first mention of claims in a statutory form in 1836. *See, e.g., Evans v. Eaton*, 20 (7 Wheat.) U.S. 161, 194 (1822) (specification concluded, "I claim as my invention, . . ."); *Philadelphia and Trenton R.R. Co. v. Stimpson*, 39 U.S. (14 Pet.) 376, 378 (1840) (discussing patent issued in 1831 as "[t]he specification describes the invention with minute particularity, and concludes: 'What I claim as my invention or improvement, is . . .'" The making of claims as a mandatory portion of the specification as provided in the Act of 1870 simply codified the preference for particular claiming already expressed by decisions of this Court. *See Brooks v. Fiske*, 56 U.S. (15 How.) 212, 215 (1853) (specification and drawings to be considered "[o]nly for the purpose of enabling us to correctly interpret the claim"). *See also, Silsby v. Foote*, 55 U.S. (14 How.) 218 (1852) (discussing "claims" of the specification). Though the statutory requisites may have changed, the essential functions of construction remained unaltered.⁸

In addition, even if the English precedents are somehow

⁸The specificity required of specifications under 18th Century English law is effectively the same as that required of claims under existing American law. *See* Pet. Brief fn. 15. With respect to the English practice of including claims at the end of a specification, it has been observed that, "[t]he distinction between the description element of the specification and the claim was a statutory creation -- Patents Act (1883), s.5-First Schedule. Actual practice long pre-dated that Act, however, to the extent that patentees did end their specifications with a statement of the features of the invention that they considered new and important. *See, R v Else* (1785), Dav. Pat Cas. 144, 1 Web. 76, Carp. 103; *Bovill v. Moore* (1816), 2 Marsh 211." *Adams & Averly, The Patent Specification: The Role of Liardet v. Johnson*, 7 J. Legal Hist. 156, n.16 (1986). This was, moreover, essential in any specification for a new improvement after such patents were validated in *Morris v. Bramson*, Davies Pat. Cas. 202 (1776), and juries construing such specifications were performing a task virtually identical to modern claim construction.

limited to juries construing the "specification" rather than the "claims" (a distinction without substance), the analysis cannot change. It is well-settled that the patent specification should be looked to in divining the scope of patent terms (*i.e.*, construction). *E. I. DuPont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir.), *cert. denied*, 488 U.S. 986 (1988) ("[i]t is entirely proper to use the specification to interpret what the patentee meant by a word or phrase in a claim"). Thus, a construction of a patent's scope often entails the need to construe the patent's specification today just as it did under English practice prior to and following 1791.⁹

Though Judge Story is acknowledged by the Federal Circuit to be "the leading intellectual property scholar of that era," (*see, Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1516 (Fed. Cir. 1995)), respondents and their supporting *amici* fail to distinguish meaningfully his views on this issue. In *Washburn v. Gould*, 29 F. Cas. 312 (C.C.D. Mass. 1844), Judge Story summarized English practice explaining that, "[T]he jury are judge of the meaning of words of art, and technical phrases, in commerce and manufactures, and of the surrounding circumstances, which may materially affect, enlarge or control the meaning of the words of the patent and specification." *Id.* at 325. Similarly, though Judge

⁹Even if it is assumed that the 1870 Act created a different claiming requirement, inventors could not thereby be stripped of their right to a jury trial in light of the Seventh Amendment's command that it be preserved. *Granfinanciera S.A. v. Nordberg*, 492 U.S. 33, 51 (1989) (Congress "lacks the power to strip parties contesting matters of private right of their Constitutional right to a trial by jury."). Moreover, respondents fail to explain why a clear historical practice of juries interpreting patents in the validity context is not sufficiently "analogous" for Seventh Amendment purposes to require jury interpretation in the closely related infringement context which is governed by the identical interpretation.

Learned Hand has been described as "one of the Nation's great patent judges" (see, Gerald Gunther, *Learned Hand: The Man And The Judge*, 138 (1994)), respondents and their amici remain silent with respect to Judge Hand's view that the interpretation of patent claims was "plainly a question of fact" subject to "clearly erroneous" review on appeal. *Harries v. Air King Products Co.*, 183 F.2d 158 (2d Cir. 1950).¹⁰

5. Respondents' Discussions Of The Precedents Of This Court Are Irrelevant And Mistaken.

Respondents devote considerable attention to attempting to establish that this Court has in the past concluded that claim construction is a matter of law in a case where there does not exist a genuine dispute as to the proper construction of a patent term. This analysis misses the point of this appeal. Respondents do not cite a single decision of this Court which even remotely supports the erroneous conclusion reached by the majority below. The Court accurately stated the controlling legal principles with respect to the interpretation of patent terms in *Evans v. Eaton*, 20 U.S. at 193-94, "[i]t is not disputed that the specification does not contain a good and sufficient description of the improved [invention], and of the manner of constructing it: and if there had been any dispute on this subject, it would have been a matter of fact for the jury, and not of law for the decision of this court."

In support of their position, respondents rely heavily upon *Winans v. New York & Erie R.R. Co.*, 62 U.S. (21 How.) 88, 101 (1858), where the Court interpreted a patent as a matter

¹⁰The views of Justice Story and Judge Hand were in accordance with the early American understanding. See, *Kneass v. Schulykill Bank*, 14 F. Cas. 746, 747 (Cir. Pa. 1820) (jury instructed that it was to resolve the interpretive dispute by reference to the patent specification, learned treatises, and expert testimony of those "acquainted with and practicing this art" and that the interpretation of the patent terms en route to an infringement finding was "for you to decide upon this evidence.")

of law since its meaning was clear from the text of the patent alone. As the Court concluded, "[i]f the construction given by the court to the specification be correct, *and in fact the only construction of which it is capable, as we think it is*, it would be wholly superfluous to examine experts that teach the court, what they could clearly perceive without such information." (emphasis supplied). This Court's decision in *Winans* is silent as to the division of responsibility between the judge and jury if a genuine dispute as to the meaning of a patent term is presented.¹¹ Respondents cite similar language from a hornbook quoted in *Coupe v. Royer*, 155 U.S. 565 (1895). Like *Winans* however, *Coupe* involved no disputed claim construction issue. Moreover, to the extent that language from *Coupe* is relevant, respondents ignore that *Coupe* explicitly reaffirmed the controlling analytical framework of *Bischoff v. Weathered*, 76 U.S. (9 Wall.) 812 (1869), see discussion *infra*. As the *Coupe* Court reiterated:

A case may be so clear that the court may feel no need of an expert to explain the terms of art or the descriptions contained in the respective patents, and may, therefore, feel authorized to leave the question of identity to the jury, under such general instruction as the nature of the document seems to require. And in such plain cases the court would probably feel authorized to set aside a verdict unsatisfactory to itself, as against the weight of the evidence. *But in all such cases, the question still would be treated as a question*

¹¹Respondents attempt to emphasize one sentence of dictum from *Winans v. Denmead*, 56 U.S. (15 How.) 339 (1853), that patent interpretation is a "question of law to be determined by construing the letters-patent" and the "specification of claim annexed to them." That dictum, however, does not address the question here presented of whether there is a right to a trial by jury when there exists a material question of fact on the meaning of a patent term. That question is affirmatively answered by *Evans v. Eaton* and *Bischoff v. Weathered*.

of fact for the jury, and not a question of law for the court. 155 U.S. at 578-79 (emphasis added) (quoting *Bischoff*, 76 U.S. (9 Wall.) at 814).

Respondents attempt to distinguish *Bischoff* as involving "whether the prior patent disclosed the same invention as the current patent," Opp. at 40, is unconvincing because *Bischoff* directly supports the proposition that a jury and not the judge must interpret both the prior and the current patents. In *Bischoff*, this Court endorsed the "common practice" of making such determinations by submitting to the jury expert testimony regarding "the nature of the various mechanisms or manufactures described in the different patents produced." The Court, emphasizing the role that the jury has in determining the meaning of the patent terms, noted that judges might set aside clearly incorrect verdicts as against the weight of the evidence, but nonetheless concluded that the question remains an issue of fact for resolution by the jury, and not as a question of law for the judge. *Id.* at 814.

Similarly, respondents attempt to distinguish *Tucker v. Spaulding*, 80 U.S. (13 Wall.) 453 (1871), as a case involving the issue of whether "an identity existed between the accused device and the patented device." Opp. 40. In *Tucker*, the Court held that an existing patent and expert testimony on the issue of "diversity or identity" were improperly withheld from a jury. The Court described the issue of identity as a "mixed question of law and fact," holding that "the resemblance [of the two patents] was close enough to require the submission of the question of identity to the jury, and the admission of the testimony of experts on that subject." *Id.* at 456.

Indeed, this is the very basis for the Court's conclusion in *Heald v. Rice*, 104 U.S. 737 (1881), where a validity defense turned on whether a reissued patent and an original one were identical. In *Heald*, the Court interpreted the two patents because their language was "clear." *Id.* at 749. The Court

expressly distinguished *Bischoff* on the basis that "If it appears on the face of the instruments that extrinsic evidence is not needed to explain terms of art," then construction or interpretation "consequently is [a] matter of law for the court." *Id.* (emphasis supplied). See also, *Market Street Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895) (patent construction presents a "matter of law for the court" where "[n]o extrinsic evidence was given or needed to explain terms of art, or to apply the descriptions to the subject matter.") (citing *Heald*).

The cases cited by respondents stand only for the proposition that where the terms themselves are clear without resorting to extrinsic evidence and no genuine issue of material fact is raised, there simply is no interpretive dispute for the jury to decide.¹² But the authorities do not support the notion that the judge can impose an interpretation where there is evidence supporting a contrary finding by the jury.

6. The Need For Construing Claim Terms Does Not Render The Patent Void For Vagueness.

In a further effort to avoid the Constitutional issue, respondents argue that if there is a factual dispute concerning the meaning of a claim term, there would be no need of further inquiry because such a dispute would, by definition, demonstrate a violation of 35 U.S.C. § 112, which requires a patentee to accurately set forth his invention in the claims of the patent. That position ignores both reality and the developed body of case law relating to the interpretation and construction of a patent claim. It is frequently the case that parties in patent litigation dispute the meaning of claim terms, which underlies the development of established claim construc-

¹²This same rationale underlies the basis for the other decisions cited by respondents as purportedly supporting their position. See, *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904); *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 276 (1877); *Loom Co. v. Higgins*, 105 U.S. 580 (1881); *Hogg v. Emerson*, 47 U.S. (6 How.) 437 (1848).

tion principles which permit a court or jury to turn to the specification, prosecution history, expert testimony and other evidence to resolve such disputes. According to respondents, if the court or jury must go beyond the patent to resolve a dispute over claim meaning, then the claim would be void for vagueness. Of course, this is not sensible and is not the law.

Courts have long recognized that language does not have the precision of a mathematical formula and that sometimes an inventor's description of his invention in his claims is the best that he can do within the limitations of expression. *See, e.g., North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 1779-80 (Fed. Cir. 1993) (claims in light of specification must only *reasonably* apprise others of scope of invention and if language is as precise as subject matter permits, no more can be demanded). If the evidence shows that persons skilled in the art would understand a term in a patent, such as in the present case where the evidence demonstrated that the term "inventory" means both physical and cash inventory, that is sufficient.

7. The Analogous Interpretive Issues Urged By Respondents Are Erroneous.

Respondents and certain of their supporting *amici* contend that construction of a patent is most analogous to a statute and that, accordingly, there is purportedly no role for the jury in interpreting the meaning of patent terms, even when there is a material factual dispute over meaning. If a patent is deemed to be a "baby statute," that might indicate that its construction is the province of the judge. However, in the two hundred year history of patent litigation in this country (as well as in the common law of England), not a single decision is cited supporting the proposition that patents are like statutes and should be construed in a like manner. This is understandable because statutes are publicly enacted laws whereas patents are grants related to a specific invention privately worked out

between the inventor and the Patent Office. This new analogy is ingenious but without foundation. It is hard to fathom how a new and dubious analogy could alter the teachings of the relevant historical record and the relevant precedents.

The great weight of authority and the more reasoned analogy is that a patent is more like a contract with the government and, accordingly, should be construed using established principles of contract interpretation. This more appropriate analogy finds support in this Court's own decisions. *See, e.g., Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880). Lower courts have adopted the same view. *See, e.g., Century Electric Co. v. Westinghouse Elec. & Mfg. Co.*, 191 F. 350, 354 (8th Cir. 1911). It was also recognized at English common law. *See* Pet. Brief, fn. 27.

Briefs of some of the *amici* supporting affirmance take issue with petitioners' suggestion that interpretation and construction of a patent, as with any written instrument, involve distinct phases of analysis which often require that certain issues be resolved by the jury. This is not a distinction created by petitioners, but is one that is well recognized in the law. As Professor Corbin explains, "The question of interpretation of language and conduct -- the question of what is the meaning that should be given by a court to the words of a contract, is a question of fact, not a question of law." *A. Corbin, Corbin on Contracts*, § 554, p. 219 (1960). Professor Corbin explains that the process of "interpretation" is determining what ideas the language in the instrument induces in other persons, while "construction" relates to a determination of the legal operation of an instrument once its meaning has been ascertained. *Corbin*, § 534 p. 8-9. His views are in agreement with those of Professor Williston. *See, Williston on Contracts*, § 602, p. 320 (3d Ed. 1961).

This distinction has a significant impact under circumstanc-

es, as in the present case, where a dispute as to the meaning of a term is presented at trial. In such circumstances, the meaning of the disputed terms must be found as a fact before construction can proceed, and it is the role of the jury to make that finding. *Corbin*, § 554 p. 226-27 (jury should resolve opposing interpretations of contract terms); *Williston*, § 616 p. 652, 660 (it is the jury's function to interpret the meaning of written terms where the meaning is not so clear as to preclude doubt by a reasonable person). Even if a patent is not considered to be a contract, the model of contract construction as described above fits squarely with issues involving the interpretation and construction of a patent.¹³

In the final analysis, the various analogies advanced by respondents and U.S. Surgical are not helpful, especially in light of the persuasive historical record and authorities supporting petitioners' position. It is telling that respondents attempt to downplay the forceful historical record while grasping for strained analogies to escape the Constitutional mandate. In Seventh Amendment jurisprudence, a page of history is more persuasive than volumes of indirect and doubtful analogies, mostly newly discovered for litigation. At English common law in 1791, the meaning of "inventory" on this record would go to the jury. The jury verdict rendered in 1991 should be preserved by the Seventh Amendment.

¹³Respondents and their *amici* rely on other tangential purported analogies, such as determinations of foreign law, meaning of land patents, jurisdiction or the admissibility of evidence. Foreign law obviously is a special situation because the inquiry by definition is one of pure law. See, *Finney v. Guy*, 189 U.S. 335, 342 (1903). Similarly, the purported analogy to land patents is misplaced as this Court has held that disputed meaning of the patent grant presents a question for the jury. *United States v. State Investment Co.*, 264 U.S. 206, 211 (1924). Since petitioners' position, based upon the relevant history and authorities, addresses the merits of the infringement finding, jurisdictional and evidentiary rulings are beside the point.

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Of Counsel

Lewis F. Gould, Jr.
Stephan P. Gribok
Eckert Seamans Cherin
& Mellott
1700 Market Street
Suite 3232
Philadelphia, PA 19103

Respectfully submitted,

William B. Mallin
Counsel of Record
Timothy P. Ryan
Timothy S. Coon
Eckert Seamans Cherin
& Mellott
600 Grant Street
42nd Floor
Pittsburgh, PA 15219

Attorneys for Petitioners
Herbert Markman and
Positek, Inc.